



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,636	04/17/2001	Srikanth Venkatraman	IN01155K	7298

24265 7590 02/19/2002

SCHERING-PLOUGH CORPORATION
PATENT DEPARTMENT (K-6-I, 1990)
2000 GALLOPING HILL ROAD
KENILWORTH, NJ 07033-0530

EXAMINER

LUKTON, DAVID

ART UNIT

PAPER NUMBER

1653

DATE MAILED: 02/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/836,636

Applicant(s)

Venkatraman

Examiner

David Lukton

Art Unit

1653

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ONE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Oct 11, 2001

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-31 is/are pending in the application

4a) Of the above, claim(s) _____ is/are withdrawn from consideration

5) ☐ Claim(s) _____ is/are allowed.

6) ☐ Claim(s) _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☒ Claims 1-31 are subject to restriction and/or election requirements

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) ☐ Other:

This application contains sequence disclosures that are encompassed by the definitions for amino acid sequences set forth in 37 CFR 1.821. However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 with regard to the sequence disclosures.

See, for example, the sequences on pages 192, 195 and 197

Applicant is given the time period set in this letter within which to comply with the sequence rules, 37 CFR 1.821-1.825. Failure to comply with these requirements will result in ABANDONMENT of the application under 37 CFR 1.821(g). Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136. In no case may an applicant extend the period for response beyond the six month statutory period.

*

A restriction is imposed, as set forth below. First, however, the following subgenera are defined:

G1: the group which contains variables Z, W, Y, X, A, E, G, V, Q and the moiety $-CH_2-CO-$ does not form a ring, i.e., variables "Z" and "V" are connected to one another via only one linking group, not two.

G2: one of substituent variables "E", "X", "W", "Y", "A" and "G" is either absent, or represents a covalent bond, and G1 is excluded.

G3: two of substituent variables "E", "X", "W", "Y", "A" and "G" are either absent, or represents a covalent bond, and G1 is excluded.

G4: three of substituent variables "E", "X", "W", "Y", "A" and "G" are either absent, or represents a covalent bond, and G1 is excluded.

G5: four of substituent variables "E", "X", "W", "Y", "A" and "G" are either absent, or represents a covalent bond, and G1 is excluded.

G6: five of substituent variables "E", "X", "W", "Y", "A" and "G" are either absent,

or represents a covalent bond, and G1 is excluded.

G7: all of the following conditions are met: (a) none of substituent variables "E", "X", "W", "Y", "A" and "G" is absent, (b) none of substituent variables "E", "X", "W", "Y", "A" and "G" represents a covalent bond, (c) integer variable "p" is not zero, and (d) subgenus G1 is excluded.

As indicated above, it is possible to interpret claim 1 as not actually requiring the presence of a macrocyclic ring. Claim 1 encompasses the possibility of all of substituent variables "E", "X", "W", "Y", "A" and "G" being absent, or representing a covalent bond. Note that in the case of variable "G", integer variable "p" can be zero, thus giving rise to either a covalent bond, or the "absence" of "G". What exactly applicants intend for the case of a substituent variable being absent is not clear; the absence of a variable could be viewed as equivalent to a covalent bond, or perhaps it could mean a discontinuity in the bonding. In any case, subgenus G1 has been created for the case in which a macrocycle is not present. This may be intended or not; if not intended, applicants can simply elect a group which requires the presence of a macrocycle. In the case of G7, all of the variables must be present, and represent something other than a covalent bond.

*

Restriction to one of the following inventions is required under 35 U.S.C. §121:

1. Claims 1-23, 26, limited to G1.
2. Claims 1-23, 26, limited to G2.
3. Claims 1-23, 26, limited to G3.
4. Claims 1-23, 26, limited to G4.
5. Claims 1-23, 26, limited to G5.
6. Claims 1-23, 26, limited to G6.
7. Claims 1-23, 26, limited to G7.

8. Claim 24, drawn to a method of using the Group 1 compounds.
9. Claim 24, drawn to a method of using the Group 2 compounds.
10. Claim 24, drawn to a method of using the Group 3 compounds.
11. Claim 24, drawn to a method of using the Group 4 compounds.
12. Claim 24, drawn to a method of using the Group 5 compounds.
13. Claim 24, drawn to a method of using the Group 6 compounds.
14. Claim 24, drawn to a method of using the Group 7 compounds.

Claim 25 is not grouped, since it is drawn to a "use". It is suggested that claim 25 be amended prior to the first Office action on the merits.

Claims 27-31 will be joined with the elected group.

The claimed inventions are distinct.

Inventions {1-7} and {8-14} are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP 806.05(h)). However, in the event that any of groups 1-7 is elected, and claims therein found allowable, claim 24 will be be rejoined for further examination, subject to the same structural limitations [*In re Ochiai* (37 USPQ2d 1127)].

Applicant is advised that for the response to this requirement to be complete, an election of the invention to be examined must be indicated, even if the requirement is traversed (37 C.F.R. 1.143).

Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

In addition to the foregoing, applicants are required under 35 U.S.C. §121 to elect a disclosed specie for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. A "specie" is a specific compound, with all substituent variables fully accounted for.


Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a generic claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP 809.02(a).

Should applicant traverse on the ground that the species are not patentable distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. §103 of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton. Phone: (703) 308-3213.

An inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.


DAVID LUKTON
PATENT EXAMINER
GROUP 1800